

REMARKS

By this amendment, claims 1, 6, 8, 10-17, and 19-26 have been amended. These amendments are made to even more clearly recite the claimed invention, do not add prohibited new matter and are fully supported by the specification. Support for the amendments to the claims may be found, for example, on page 24, lines 18-24, of the specification. Reconsideration and withdrawal of the rejections set forth in the outstanding Office Action are respectfully requested in view of the following remarks.

Interview Summary

Applicants would like to thank Examiner Holliday for her courtesy in conducting a telephone interview with Applicants' representative, Azza Jayaprakash and William Pieprz, on January 11, 2008. In the telephone interview, Applicants' representatives also briefly discussed the previous rejection under 35 U.S.C. § 101, and thank the Examiner for indicating that the previous rejection under 35 U.S.C. § 101 was withdrawn. Applicants' representatives then discussed the amendments to the claims made herein and the outstanding rejections under 35 U.S.C. § 103(a). Applicants' representatives discussed elements of the claims which distinguish the claimed invention from the cited publications (discussed in detail herein). The Examiner agreed that the claim amendments further clarified the scope of the claimed invention. The Examiner indicated that she would take Applicants' remarks and claim amendments into consideration after reviewing Applicants' response to the outstanding Office Action. Lastly, Applicants thank the Examiner for indicating that she would contact Applicants' representatives, after considering the Office Action response, if there were additional amendments that could be made to advance prosecution to allowance of the present application.

Rejections under 35 U.S.C. § 103(a)

The Office Action rejects claims 1-26 under 35 U.S.C. § 103 as being unpatentable. In particular, the Office Action rejects claims 1-10, 13, 14, 17-20, and 23, and 24 under 35 U.S.C. § 103(a) as being unpatentable over WAESTERLID (WO 01/65807) and EIDEN et al. (U.S. Pat. App. Pub. No. 2002/0168992), in further view of KAWAGUCHI et al. (U.S. Pat. App. Pub. No. 2002/0037736), and further in view of ANTTILA et al. (U.S. Patent Application Publication No. 2006/0019702). The Office Action also rejects claims 11, 12, 15, 16, 21, 22, 25, and 26 under § 103(a) as being unpatentable over WAESTERLID in view of KAWAGUCHI et al., and in further view of ANTTILA.

Initially, Applicants note that claim 1 recites:

A mail exchange system, comprising:

- a plurality of terminal devices connected to one another via a communications network, each terminal device having a member information storage that stores member information of members who belong to a group that exchange mail via said communications network, the plurality of the terminal devices comprising a specific member terminal, an existing member terminal, and a newly joining member terminal;

- said specific member terminal includes:

- a participation mail receiver that receives participation mail, including member information of a member who newly joins the group, from said newly joining member terminal via said communications network;

- a first member information adder that extracts the member information included in the participation mail received by said participation mail receiver and stores the extracted member information in the member information storage; and

- a new member information mail transmitter that transmits a new member mail, including the member information of the newly joining member, to said existing member terminal according to information stored in said member information storage via said communications network,

- said existing member terminal including:

- a new member information mail receiver that receives the new member mail;

- a second member information adder that extracts the member information included in the received new member mail and stores the extracted member information in a member list in the member information storage; and

a self-information mail transmitter that transmits an existing member mail, including self-member information, to said newly joining member terminal via said communications network, and
said newly joining member terminal including:

a new participation mail transmitter that transmits the new member mail, including self-member information of the newly joining member, to said specific member terminal via said communications network;

an existing member information mail receiver that receives existing member mail from a plurality of existing member terminals; and

a member information generator that generates entries in a member list stored in the member information storage by extracting the self-member information from the received existing member mail from the plurality of existing member terminals, other than the specific member terminal,

wherein group identification information, indicating the group exchanging the mail, is added to the mail to be exchanged among said terminal devices of the members belonging to the group, and the group identification information comprises user identification information of the terminal device of a member who forms the group and a time when said group is formed, and

wherein the group identification information is a unique identifier for each group, and the group identification information can be generated at the terminal device of the member who forms the group.

Independent claims 8, 10-17, and 19-26 recite generally similar limitations.

Applicants further note that the Examiner has acknowledged that WAESTERLID, EIDEN et al., and KAWAGUCHI et al. fail to disclose or suggest that “the time the group is formed is included in the correspondence” (*see, e.g.,* page 10 of the outstanding Office Action). Therefore, the Examiner relies upon ANTTILA et al. to teach this feature. However, Applicants note, although ANTTILA et al. discloses time information, ANTILLA et al. only disclose a time stamp. In ANTTILA et al., this time stamp is not used to form group identification information to specify or identify a group, as recited in the claims. Furthermore, there is nothing in any of the publications, including ANTILLA et al., that suggests that the time stamp should be used to form or generate group identification information to specify or identify a group.

In contrast, in the claimed invention, the “the group identification information comprises user identification information of the terminal device of a member who forms the group and a

time when said group is formed,” as generally recited in the independent claims. Because each member has a unique user ID (or user identification information) and a member cannot form multiple groups at the same time, the group identification information is a unique identifier, which specifies or identifies each group.

Furthermore, in the present claimed invention, when a user forms a new group, the terminal device *itself* can obtain user identification information and the time the group was formed. In other words, even if there is no server to unify the management of group information for each group, the specified member terminal device can still generate or form group identification information. This group identification information, which is generated or formed at the specified member terminal device, is added to all mails sent and received among group members as an ID which specifies or identifies each group. Because the Examiner admits that WAESTERLID, EIDEN et al., and KAWAGUCHI et al. fail to disclose or suggest the aforementioned elements, and ANTTILA et al. also fail to disclose or render obvious the use of time information in the generation or formation of group identification information (or the advantages which stem from this feature), Applicants submit that the Examiner has not satisfied a *prima facie* case for obviousness, and respectfully request withdrawal of the outstanding rejections under 35 U.S.C. § 103.

Furthermore, Applicants submit that it would be improper to assume that simply because ANTTILA et al. disclose a time stamp that one skilled in the art would use the time stamp to form or generate the group identification information in the manner recited in the claims. Such an assumption would be without any reasoning without some rational underpinning to support a determination of obviousness.

Under MPEP § 2143.01, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” Indeed, the Supreme Court has refined the standards for obviousness in *KSR International v. Teleflex*. However, the Court has not abandoned the requirement for any motivation or suggestion in the art to combine the teachings of two publications. Rather, the recent *KSR* decision supports combining teachings of publications in cases where “there is [a] design need or market pressure to solve a problem, and there are finite number of identified, predictable solutions.” *KSR International v. Teleflex*, 127 S. Ct. 1727, 1742 (2007). In this instance, there is not a finite number of identified, predictable solutions because there are a myriad of ways to approach the problem of identifying a group in this technology field. Thus, Applicants submit that there is insufficient motivation to combine the cited publications in the manner suggested by the Examiner. Furthermore, even assuming *arguendo*, that certain individual elements of the claimed invention are known in the art, there is no reason or suggestions that would guide one skilled in the art to arrive at the claimed combination.

Accordingly, in view of the above arguments and remarks, Applicants respectfully request reconsideration of each of the outstanding rejections asserted against Applicants’ claims 1-26 pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

SUMMARY AND CONCLUSION

In view of the foregoing, it is submitted that Examiner's rejections should be withdrawn. Entry and consideration of the present amendment, reconsideration of the outstanding Office Action, and allowance of the present application and all of the claims therein are respectfully requested and now believed to be appropriate.

Although it is within the discretion of the Examiner to enter amendments made after a Final Office Action, Applicants submit that the amendments clarify previously recited claim elements, do not raise new issues, and should not necessitate a new search. Accordingly, Applicants respectfully request that the Examiner enter the amendments. Applicants have made a sincere effort to place the present invention in condition for allowance and believe that they have now done so.

Applicants note that this amendment is being made to advance prosecution of the application to allowance, and should not be considered as surrendering equivalents of the territory between the claims prior to the present amendment and the amended claims. Further, no acquiescence as to the propriety of the Examiner's rejection is made by the present amendment. All other amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Commissioner determine that an extension of time is required in order to render this response timely and/or complete, a formal request for an extension of time, under 37 C.F.R. §1.136(a), is herewith made in an amount equal to the time period required to render this response timely and/or complete. The Commissioner is authorized to charge any required extension of time fee under 37 C.F.R. §1.17 to Deposit Account No. 19-0089.

P25084.A07

Should the Examiner have any questions, please contact the undersigned at the telephone number provided below.

Respectfully Submitted,
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January 11, 2008
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